

ESTTA Tracking number: **ESTTA65912**

Filing date: **02/10/2006**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	L'Oreal USA Creative, Inc.
Granted to Date of previous extension	02/15/2006
Address	575 Fifth Avenue New York, NY 10017 UNITED STATES

Attorney information	Nikki A. Hart Paul, Hastings, Janofsky & Walker LLP 75 E. 55th Street New York, NY 10022 UNITED STATES nikkihart@paulhastings.com Phone:(212) 318-6256
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Applicant Information

Application No	78441325	Publication date	10/18/2005
Opposition Filing Date	02/10/2006	Opposition Period Ends	02/15/2006
Applicant	HealthTan Technologies 17 Laurelwood Drive Mount Vernon, OH 43050 UNITED STATES		

Goods/Services Affected by Opposition

Class 003. All goods and services in the class are opposed, namely: Cosmetic preparations for sunless tanning and sunless tanning sprays marketed as a complement to professional spa services

Attachments	Notice of Opposition VITA MATRIX.pdf (24 pages)
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Signature	/Nikki A. Hart/
Name	Nikki A. Hart
Date	02/10/2006

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 78/441,325
Published in the Official Gazette on October 18, 2005
Mark: VITA MATRIX

L'ORÉAL USA CREATIVE, INC.,

Opposer,

v.

HEALTHTAN TECHNOLOGIES,

Opposition No. _____

Applicant.

NOTICE OF OPPOSITION

L'Oréal USA Creative, Inc. ("L'Oréal" or "Opposer") believes it will be damaged by registration of the mark VITA MATRIX by applicant Healthtan Technologies ("Applicant") in Class 3 for "cosmetic preparations for sunless tanning and sunless tanning sprays marketed as a complement to professional spa services," and hereby opposes same, by and through its attorneys, Paul, Hastings, Janofsky and Walker LLP, on the following grounds:

1. L'Oréal is a Delaware corporation having a business address of 575 Fifth Avenue, New York, NY 10017.

2. L'Oréal and its affiliates are now and for many years past have been engaged in the development, manufacture, distribution, marketing and sale of nearly all categories of beauty products, including skin care products, sun care products, hair care products and cosmetics, as well as salon-oriented products. L'Oréal's products are distributed through various channels, which

include department stores, specialty stores, drugstores, food stores, mass merchandisers and beauty salons.

3. L'Oréal is the owner of the following trademarks and federal trademark registrations (collectively, the "MATRIX" Mark):

Mark	Status	No.	Priority Date	Goods/Services
MATRIX	Registered	1,569,113	1/19/89	Skin care preparations, namely cleansing wash, foaming gel wash, skin freshener, purifying toner, exfoliating scrub, revitalizing masque, hydrating lotion, moisturizing lotion and cream, night cream, firming eye cream, and regeneration skin supplement
MATRIX	Registered	2,226,310	9/25/1980	Hair care products, namely, shampoos, conditioners, rinses, styling lotions, gels, glazes, tonics, permanent waves, hair coloring preparations, color additives, bleaches, hair polish, styling foams, leave-in curl retention preparations, and hair spray
MATRIX	Registered	2,529,847	06/1998	Printed material, namely, newsletters in the field of hair care distributed to and through professional salons and professionals in the hair care trade

A copy of the USPTO Trademark Application and Registration Retrieval System records for the MATRIX Mark is annexed hereto as Exhibit A.

4. L'Oréal acquired rights in MATRIX prior to any rights that may be asserted by Applicant in the subject application.

5. L'Oréal offers a comprehensive line of hair care, hair color and hair texturizing products and services under its well-known MATRIX Mark. Introduced in 1980, that line has grown to include a wide range of shampoo, conditioning, styling and finishing products, as well as various salon products including hair color and texturizing lotions. L'Oréal has also offered, from time to time, MATRIX skin care preparations.

6. For more than two decades, L'Oréal (including its predecessor-in-interest) has produced, advertised, promoted, distributed and sold, *inter alia*, professional hair care and related products in interstate commerce under its famous MATRIX Mark.

7. Some of L'Oréal's well-known lines of professional hair care products sold under the MATRIX house mark include BIOLAGE, MATRIX ESSENTIALS, SLEEK.LOOK, AMPLIFY, OPTI.SMOOTH, LOGICS, VAVOOM, SOCOLOR, CURL.LIFE, and COLOR.SMART.

8. L'Oréal's MATRIX products are available in tens of thousands of salons throughout North America, as well as in other parts of the world.

9. Thousands of educational events are held annually in classrooms, on stage and in salons by or on behalf of L'Oréal's MATRIX products and services. Those events include demonstrations of the newest methods of cutting, coloring and texturizing, and presentations on business building strategies for salons. A newsletter published under the MATRIX Mark, with a circulation in excess of 200,000 is distributed bi-monthly, and covers a wide variety of topics, including color formulas, new product introductions and hair style trends.

10. More recently, the Matrix Global Academy in New York City was opened, occupying more than 11,000 square feet of state-of-the-art training facilities, and offering a wide range of courses to salon owners and stylists.

11. Consumers and professionals have come to know and trust L'Oréal's MATRIX brand for its premium hair care products and services to such an extent that the MATRIX brand is

among the most recognizable and famous in the field. As a result, it now is the number one brand in hair care products sold through salons. Printouts from the www.matrix.com web site are annexed hereto as Exhibit B.

12. As a direct result of the continued prominence and visibility of MATRIX products, they long ago acquired widespread recognition and an outstanding reputation among consumers and the trade. Such consumer and trade acceptance has resulted in a brand that is among the most successful of its kind.

13. L'Oréal has exercised great care, skill and diligence in conducting its business, and has maintained uniform standards of high quality in making and selling its MATRIX products. By virtue of those high standards, more than twenty-five years of continuous and substantially exclusive use, and the expenditure of tens of millions of dollars in advertising and promotion, the MATRIX Mark has become famous and symbolizes L'Oréal's extensive and valuable goodwill throughout the United States.

14. On information and belief, Applicant is corporation with a business address of 17 Laurelwood Drive, Mount Vernon, Ohio 43050.

15. On information and belief, Applicant's VITA MATRIX is held out as a sunless tanning solution and formula that contains pharmaceutical grade DHA and Erythrulose, among other ingredients, and is used in airbrush guns found in tanning booths that spray on a tan, as well as in sunless tanning products for at-home use. As noted in Applicant's application for registration, its VITA MATRIX products are "marketed as a complement to professional spa services." Applicant's VITA MATRIX so resembles L'Oréal's MATRIX Mark as to be likely, when applied to Applicant's goods, to cause confusion or mistake or to deceive, so that registration thereof would damage L'Oréal. As such, Applicant's mark is not entitled to registration pursuant to 15 U.S.C. § 1052(d).

16. On information and belief, Applicant began its use of VITA MATRIX after L'Oréal's MATRIX Mark became famous.

17. Because of the fame of L'Oréal's MATRIX Mark and the similarity of VITA MATRIX to the MATRIX Mark, Applicant's use of VITA MATRIX dilutes the ability of L'Oréal's famous MATRIX Mark to identify L'Oréal's goods. As such, Applicant's mark is not entitled to registration under 15 U.S.C. § 1052(f).

18. L'Oréal believes it will be damaged by the registration sought herein by Applicant's proposed mark within the meaning of 15 U.S.C. § 1063(a).

19. This opposition is timely filed and accompanied by a filing fee of \$300.00.

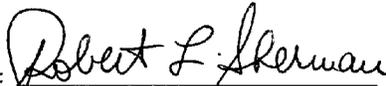
WHEREFORE, L'Oréal respectfully requests that

- (i) the registration sought by Applicant be refused;
- (ii) the Notice of Opposition be sustained; and
- (iii) the Trademark Trial and Appeal Board grant such other relief as it deems just and proper.

Dated: February 10, 2006

Respectfully submitted,

PAUL, HASTINGS, JANOFSKY &
WALKER LLP

By: 
Robert L. Sherman
Nikki A. Hart

75 East 55th Street
New York, NY 10022
(212) 318-6000

Attorneys for Applicant
L'Oréal USA Creative, Inc.

EXHIBIT A

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2006-02-10 09:56:07 ET

Serial Number: 73789454 [Assignment Information](#)

Registration Number: 1569113 [Assignment Information](#)

Mark (words only): MATRIX

Standard Character claim: No

Current Status: This registration has been renewed.

Date of Status: 1999-09-20

Filing Date: 1989-03-27

Transformed into a National Application: No

Registration Date: 1989-12-05

Register: Principal

Law Office Assigned: (NOT AVAILABLE)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -File Repository (Franconia)

Date In Location: 2001-05-31

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. MATRIX ESSENTIALS, INC.

Address:

MATRIX ESSENTIALS, INC.
30601 CENTER STREET
SOLON, OH 44139
United States

Legal Entity Type: Corporation

State or Country of Incorporation: Ohio

GOODS AND/OR SERVICES

International Class: 003

SKIN CARE PREPARATIONS, NAMELY CLEANSING WASH, FOAMING GEL WASH, SKIN

FRESHENER, PURIFYING TONER, EXFOLIATING SCRUB, REVITALIZING MASQUE,
HYDRATING LOTION, MOISTURIZING LOTION AND CREAM, NIGHT CREAM, FIRING
EYE CREAM, AND REGENERATION SKIN SUPPLEMENT

First Use Date: 1989-01-19

First Use in Commerce Date: 1989-01-19

Basis: 1(a)

ADDITIONAL INFORMATION

Prior Registration Number(s):

773807

1277705

1479259

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

1999-09-20 - First renewal 10 year

1999-07-26 - Section 9 filed/check record for Section 8

1996-05-15 - Section 8 (6-year) accepted

1995-10-11 - Section 8 (6-year) and Section 15 Filed

1989-12-05 - Registered - Principal Register

1989-09-12 - Published for opposition

1989-09-12 - Published for opposition

1989-08-12 - Notice of publication

1989-06-15 - Approved for Pub - Principal Register (Initial exam)

1989-06-13 - Case file assigned to examining attorney

CORRESPONDENCE INFORMATION

Correspondent

SUSAN R. REISS (Attorney of record)

SUSAN R REISS

BRISTOL-MYERS SQUIBB COMPANY

Latest Status Info

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345 PARK AVENUE
NEW YORK NY 10154

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2006-02-10 09:56:35 ET

Serial Number: 75475522 [Assignment Information](#)

Registration Number: 2226310 [Assignment Information](#)

Mark (words only): MATRIX

Standard Character claim: No

Current Status: Section 8 and 15 affidavits have been accepted and acknowledged.

Date of Status: 2004-09-23

Filing Date: 1998-04-28

Transformed into a National Application: No

Registration Date: 1999-02-23

Register: Principal

Law Office Assigned: LAW OFFICE 107

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -File Repository (Franconia)

Date In Location: 2004-09-28

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. L'OREAL USA CREATIVE, INC.

Address:

L'OREAL USA CREATIVE, INC.
575 FIFTH AVENUE
NEW YORK, NY 10017
United States

Legal Entity Type: Corporation

State or Country of Incorporation: Delaware

GOODS AND/OR SERVICES

International Class: 003

Hair care products, namely, shampoos, conditioners, rinses, styling lotions, gels, glazes, tonics,

permanent waves, hair coloring preparations, color additives, bleaches, hair polish, styling foams, leave-in curl retention preparations, and hair spray

First Use Date: 1980-09-25

First Use in Commerce Date: 1980-09-25

Basis: 1(a)

ADDITIONAL INFORMATION

Prior Registration Number(s):

1277705
1539973
1555023
1569113
1579510
1667123
1737909
1806648
1868380

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2004-09-23 - Section 8 (6-year) accepted & Section 15 acknowledged

2004-08-03 - Section 8 (6-year) and Section 15 Filed

2004-08-03 - TEAS Section 8 & 15 Received

1999-02-23 - Registered - Principal Register

1998-12-01 - Published for opposition

1998-10-30 - Notice of publication

1998-09-22 - Approved for Pub - Principal Register (Initial exam)

1998-09-15 - Case file assigned to examining attorney

CORRESPONDENCE INFORMATION

Correspondent

LISA M. GIGLIOTTI
L'OREAL US CREATIVE, INC.
34TH FLOOR, 575 FIFTH AVENUE

Latest Status Info

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NEW YORK, NY 10017

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2006-02-10 09:56:59 ET

Serial Number: 76267047

Registration Number: 2529847

Mark (words only): MATRIX

Standard Character claim: No

Current Status: Registered.

Date of Status: 2002-01-15

Filing Date: 2001-06-05

Transformed into a National Application: No

Registration Date: 2002-01-15

Register: Principal

Law Office Assigned: LAW OFFICE 115

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -File Repository (Franconia)

Date In Location: 2002-02-01

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. L'Oreal USA Creative, Inc.

Address:

L'Oreal USA Creative, Inc.
575 Fifth Avenue
New York, NY 10017
United States

Legal Entity Type: Corporation

State or Country of Incorporation: Delaware

Phone Number: (212) 984-4177

Fax Number: (212) 984-5082

GOODS AND/OR SERVICES

International Class: 016

Printed material, namely, newsletters in the field of hair care distributed to and through professional salons and professionals in the hair care trade

First Use Date: 1998-06-00

First Use in Commerce Date: 1998-06-00

Basis: 1(a)

ADDITIONAL INFORMATION

Prior Registration Number(s):

1277
1539973
1555023
1569113
1868380
2187874
2226310

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2002-01-15 - Registered - Principal Register
2001-10-23 - Published for opposition
2001-10-03 - Notice of publication
2001-09-04 - Approved for Pub - Principal Register (Initial exam)
2001-08-29 - Case file assigned to examining attorney

CORRESPONDENCE INFORMATION

Correspondent

Lisa M. Gigliotti (Attorney of record)

LISA M. GIGLIOTTI
L'OREAL USA CREATIVE, INC.
575 5TH AVE
NEW YORK NY 10017-2422

Phone Number: (212) 984-4177

Fax Number: (212) 984-5082

EXHIBIT B

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Matrix Destination 2006



Click here for most exciting stylist event in 2006 - **Matrix Destination**

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Matrix Spotlight



Matrix Celebrity Stylist, Enzo Angileri, featured in *People* Magazine

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Matrix Spotlight



Matrix celebrity colorist Jennifer J talks about the "right" red in Marie Claire

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Haircare and Styling

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Curl.life

Logics

Matrix Essentials

Sleek.look

Trix

Vavoom

Haircolor and Texture

Colorgraphics

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Logics Color

Matrix Texture

Opti.smooth

Socolor

Vlight



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Vision

Matrix inspires all salon professionals to transform a passion for beauty into personal success.

Mission

Be the universal leader and iconic brand of professional salon beauty through our commitment to:

- Partnerships
- Innovation
- Support

Values

- Integrity
- Diversity
- Enthusiasm
- Accountability
- Leadership

Salon Professional Website:

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Vlight

Matrix products racked up the awards in 2005.

[Matrix Spotlight](#)
[Press Releases](#)
[Product Awards](#)
[Product Award Archives](#)



In 2005, beauty editors and consumers concluded that Matrix has some of the best products out there for hair. From shampoos and conditioners to styling products, Matrix brands racked up many beauty awards in 2005! [Check out what Matrix won for!](#)

May 2005 - Matrix Wins Top Beauty Awards from *Self* Magazine



The self proclaimed SATs of beauty, *Self* Magazine's Healthy Beauty Awards separate the good from the great. While 1,000 new products were nominated, just 75 of the newcomers were selected as the winners currently featured in the magazine's 6th annual awards issue - including 2 from Matrix. Selected by over 1,200 *Self* readers, Biolage Fortifying Heat Styler, winner for "Best Heat Styling Protector," was praised for dramatically reducing breakage after only a few weeks, while WetTrix captured the prize for "Best Texturizer" and was noted for giving "a slick, just showered sheen that stays put for hours." Check out the May issue of *Self* - on newsstands now - to find out more on your favorite products and see Matrix highlighted with this year's true standouts. Congratulations Matrix!

May 2005 - Matrix received two awards at this year's *Men's Health* "Best Looks Grooming Awards"



Matrix was thrilled to receive two awards at this year's *Men's Health* "Best Looks Grooming Awards," held Tuesday at NYC's Lever House. The May issue announces all winners, listing Amplify Gel-Wax as "Best Wax Runner-up" and DirtyTrix as "Best Clay Best Buy." Beating out a range of top competitors, the two Matrix products were also mentioned in the Awards' program and were recognized with two plaques to add to the trophy case. Congratulations!

April 2005 - Matrix wins at the BTC Stylist Choice Awards!



Twenty-five years later, Matrix is still true to its "for stylists, by stylists" roots. So what better award to win than one given by stylists themselves! This past weekend, Matrix took home three awards at behindthechair.com's 5th Annual Stylist Choice Awards held at Crobar in New York City. The event selected winners from a unique fill-in the blank survey taken by 100,000 stylists on behindthechair.com over the course of two weeks. Matrix honorees included Sleek.look as Favorite Straightening Product, Amplify as Favorite Volumizing Product, and Color.smart as Favorite New Liquid Product. Congratulations Matrix!

Salon Professional Website:

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Haircare and Styling

- Amplify
- Biolage
- Color.smart
- Curl.life
- Logics
- Matrix Essentials
- Sleek.look
- Trix
- Vavoom

Haircolor and Texture

- Colorgraphics
- Colorsync
- Logics Color
- Matrix Texture
- Opti.smooth
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amplify

Amplify 4-Step Volumizing System is real patented technology proven to increase the thickness of hair.



BIOLAGE

Discover professional haircare with a therapeutic vision. A collection of therapies fusing Matrix science with customized natural ingredients for a rejuvenating salon experience.



color.smart

Color.smart Protective Luminating System keeps your shade salon-luminous and true to hue.



curl.life

Curl.life 4-Step Defining System's unique technology fuses moisture and control to professionally tame curls every step of the way.



Haircolor and Texture

At Matrix, we know that changing a look can change a life. That's why we have color and texture products for any look you can imagine. Matrix color and texture is available exclusively by professional stylists.



LOGICS FOR MATRIX

Logics Coloreserve is a unique formula that acts as a UV absorber and photofilter to help prevent the drying and dulling of hair and the loss of hair's strength and elasticity.



essentials

Matrix Essentials is the salon professional's chemical service support partner.



sleek.look

Sleek.look 4-Step Smoothing System is an amazing breakthrough in technology that lets you smooth curls, tame frizz and blow-dry hair straight.



TRIX

Trix styling products let you create multiple styles with just one product or blend together to customize effects.



Vavoom Designing and Finishing System lets you take control of your style. Shape it. Shine it. Define it.

Salon Professional Website:

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Haircare and Styling

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